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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,543	04/12/2000	Beatty Graydon	1931	6325

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EXAMINER

MCCROSKY, DAVID J

ART UNIT PAPER NUMBER

3736

DATE MAILED: 05/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,543

Applicant(s)

BEATTY ET AL.

Examiner

David J. McCrosky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: "divisional" in line 2 of the first paragraph of the specification should be --continuation-in-part-- because 09/005,105 is a continuation-in-part of 08/387,832; the year of the filing date for PCT/US93/09015 should read --1993-- not "1992"; the year of the filing date for 07/950,448 should read --1992-- not "1993"; and patent number "5,291,549" in line 5 of the first paragraph of the specification should read --5,297,549--.

37 C.F.R. 1.78(a)(2) states that Applicant must identify the application to which priority is claimed and the relationship of the applications. The last sentence of the first paragraph of the specification "Applicants claim priority to" should be deleted since there is no established relationship between 08/376,067 and 08/178,128 and the instant application and since Applicant has already stated the relationship to 08/387,382. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budd et al (5,553,611) in view of Ben-Haim. Budd et al disclose a process for mapping and representing the three-dimensional structure of the heart chamber that includes passive measurement and active interrogation electrodes, a signal generator and a means for representing the endocardial wall. The reference further discloses a mapping catheter assembly having measurement electrodes and excitation electrodes. See cols. 1 and 2. Budd et al do not teach a therapy catheter. However, Ben-Haim teaches the use of a mapping/ablation catheter, locating the catheter and superimposing the image of the catheter on a heart chamber image. See cols. 3 and 5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Budd et al with the use of a mapping/therapy catheter as taught by Ben-Haim, since this facilitates mapping and identification of lesions and subsequent application of therapy.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,662,108 issued to Budd et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because although Budd et al do not claim time domain extraction, it would have been obvious to one of ordinary skill in the art to perform an extraction either in the frequency domain or time domain for the purpose of obtaining the necessary component of measurement data since it was known in the art that frequency domain and time domain extraction are practical methods of processing measurement data. Applicant has claimed subject matter broader than Budd et al. Any process meeting the claims of Budd et al would necessarily meet those of the instant application.

Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,662,108 issued to Budd et al in view of Ben-Haim. Budd et al disclose a process for mapping and representing the three-dimensional structure of the heart chamber that includes passive measurement and active interrogation electrodes, a signal generator and a means for representing the endocardial wall. The claim further discloses a mapping

process. See claim 1. The claim of Budd et al does not teach a therapy catheter. However, Ben-Haim teaches the use of a mapping/ablation catheter, locating the catheter and superimposing the image of the catheter on a heart chamber image. See cols. 3 and 5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process claimed in Budd et al with the use of a mapping/therapy catheter as taught by Ben-Haim, since this facilitates mapping and identification of lesions and subsequent application of therapy.

Response to Arguments

Examiner notes that Applicant has stated that a terminal disclaimer will be filed upon the indication of allowability of claims 2 and 3.

Applicant has asked for the determination of priority under 35 U.S.C. §120 of application 8/387,832, now patent number 6,240, 307. It is not proper to determine priority of the above application during prosecution of the instant application. A request for reexamination of application 8/387,832 is not shown in USPTO records.

Applicant has contended that neither reference used in the 103(a) rejection above is prior art. U.S. patent number 5,553,611 is not in the chain of continuity for the instant application. Patent numbers 5,311,866 and 5,297,549 each have an effective filing date of September 23, 1992. The effective filing date for the invention of the instant application is the date when the entire claimed invention is disclosed and the disclosure is carried throughout the chain of continuity leading to the instant application. Patents '866 and '549 do not disclose the combination of elements as claimed in claims 2 and 3.

The effective filing date for the instant application is considered to be January 9, 1998.

Therefore, Ben-Haim is considered prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric F. Winakur can be reached on 703-308-3940. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DJM
May 6, 2003

A handwritten signature in black ink, appearing to read 'E. Winakur', with a stylized flourish at the end.

ERIC F. WINAKUR
PRIMARY EXAMINER